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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/559,725	04/28/2000	Michael A. Costonis	07752.0023-00000	4297

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EXAMINER

FRENEL, VANEL

ART UNIT PAPER NUMBER

3626

DATE MAILED: 01/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/559,725

Applicant(s)

COSTONIS ET AL.

Examiner

Vanel Frenel

Art Unit

3626

The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-108 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-108 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the Amendment filed 10/13/04. Claims 1, 6, 55-77, 82 have been amended. Claims 1-108 are pending.
2. Due to Applicant's amendment, the rejection under 35 U.S.C. 101 is hereby withdrawn.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 6, 55-77 and 82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hammond et al (5,712,984), Moore et al (5,930,759), Little et al (5,359,509) and further in view of "SAP, Anderson Offer P-C Product" by Trembly, for substantially the same reasons given in the previous Office Action. Further reasons appear hereinbelow.

(A) Claims 1 and 6 were apparently amended to include the words "with the electronic data processing system". This change appears to have been made to address 101 issues raised in the previous Office Action. However, this change does not

affect the scope and the breadth as originally presented and/or in the manner in which were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(B) Claims 55-77 were apparently amended to include the words "executable"; "executable instructions stored on a computer-readable medium for". This change appears to have been made to address 101 issues raised in the previous Office Action. However, this change does not affect the scope and the breadth as originally presented and/or in the manner in which were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(C) Claim 82 was apparently amended to include the words "an electronic data processing"; "the electronic" and "with the electronic data processing system". This change appears to have been made to address 101 issues raised in the previous Office Action. However, this change does not affect the scope and the breadth as originally presented and/or in the manner in which were interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(D) Claims 2-5, 7-54, 78-81 and 83-108 have not been amended and are therefore rejected for the same reasons given in the previous Office Action, and incorporated herein.

Response to Arguments

5. Applicant's arguments filed on 10/13/04 with respect to claims 1, 6, 55-77 and 82 have been fully considered but they are not persuasive. Applicant's will be addressed hereinbelow in the order in which they appear in the response filed 10/13/04.

(A) At pages 21-26 of the 10/13/04 response, Applicant argues the followings:

(1) The rejection under 35 U.S.C 103 (a) should be withdrawn.

(2) The cited art does not teach or fairly suggest the claimed invention.

(3) The applied references fail to disclose the step of "selections at least one best practice from a predetermined set of best practices associated with a claims handling process" as recited in claim 1.

(4) The applied references fail to disclose "determining a best practice associated with processing the plurality of claims based on the loss economic opportunity" as recited by claim 1.

(B) With respect to Applicant's first and second arguments, Examiner respectfully submits that that obviousness is not determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783F.2d 1038, 1039, 228

USPQ 685, 686 (Fed. Cir.1992); *In re Piaseckii*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir.1984); *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a prima facie case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (See the previous Office Action). Note, for example, in the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references are accompanied by select portions of the respective reference(s) which specially support that particular motivation and /or an explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness. As such, it is not seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one of ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood*, 28 USPQ2d 1300(Bd. Pat. App.& Inter., 4/22/93). Therefore, the combination of references is proper and the rejection is maintained.

In addition, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees

that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). Therefore, Applicant's argument is not persuasive.

Further, it is respectfully submitted that Applicant merely provides a piecemeal analysis of the teachings of the Hammond, Moore, Little and Trembly references, separately, and in a vacuum. As such, it is respectfully submitted that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, with specific reference to Applicant's remarks about the Trembly reference, the Examiner respectfully submits that it is sufficient to demonstrate that the prior art meets the limitations as claimed, whether by a single instance or scenario, or in every possible preferred embodiment, since it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

(C) With respect to the third argument, Examiner respectfully submits that Andersen suggests "The new property-casualty application will focus on claims processing, and

area that represents more than 80 percent of a p-c insurer's cost of doing business" the announcement stated. This solution will be based on the SAP Business Framework and Andersen Consulting's claims design, which embodies the firm's vision of future best practices which correspond to Applicant's claimed feature (See Andersen, Page 1, Paragraphs 7-8). Therefore, Applicant's argument is not persuasive.

(D) With respect to the third argument, Examiner respectfully submits that Andersen suggests "The application is intended to enable insurers to improve loss adjustment expenses by 20 percent to 40 percent while reducing money paid out on claims by an estimated three to five percentage points" which correspond to Applicant's claimed feature (See Andersen, Page 1, Paragraph 13). Therefore, Applicant's argument is not persuasive.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952. The examiner can normally be reached on Monday-Thursday from 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

V.F
V.F

January 20, 2005


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600